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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,203	12/03/2003	Nancy L. Klodt	P06446US00	5137
22885	7590	06/15/2005	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C.			SUHOL, DMITRY	
801 GRAND AVENUE			ART UNIT	
SUITE 3200			PAPER NUMBER	
DES MOINES, IA 50309-2721			3725	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/727,203	Applicant(s) KLODT, NANCY L	
	Examiner Dmitry Suhol	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/3/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7, 8, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmkuhl '495 in view of Buckley et al '380. Lehmkuhl discloses a desktop teaching aid containing most of the elements of the claims including with reference to claim 1, a body having a top surface (figure 1) and a bottom surface comprising a magnetic material for attachment to a desk (col. 2, lines 56-62), a body defining a frame (figure 1), educational information represented on top of the body (indicia shown in figure 1). The educational material being selected from mathematical material, geographical material or reading material, as required by claim 3, is shown as letter chart 20 and number line 22.

Lehmkuhl fails to teach an aperture (sleeve as required by claim 2) and a replaceable name tag within the aperture of the body as required by claim 1. However, Lehmkuhl discloses that his aid is envisioned to contain a student's name in a location within the aid (col. 4, lines 52-54), while Buckley discloses a similar device which teaches that it is known to provide such devices with an aperture/sleeve (pocket 17) which holds a name tag of the user (col. 4, lines 1-12). Therefore it would have been

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obvious to one having ordinary skill in the art, at the time of the claimed invention to have manufactured the aid of Lehmkuhl with apertures/pockets/sleeves and for holding removable name tags for the purpose of allowing names to be replaced allowing a variety of users to use the device. The educational material being located in a plurality of regions in the body, as required by claim 7, is shown in figure 1 where the educational material is scattered throughout the body.

Regarding claims 4-5, It would have been obvious to one having ordinary skill in the art at the time of the claimed invention to include matching decorative designs on a name tag and body of the teaching aid as well as educational material on the name tag since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983) and *In re Ngai*, 367 F.3d 1336, 70 USPQ2d 1862. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of aesthetic appearance does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. decorative design and educational material) and the substrate (e.g. body of the aid and name tag) which is required for patentability. Furthermore it is the position of the examiner that the decorative design and placement of the educational material as claimed is purely a

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design choice in that applicants do not disclose any advantage or critical need for the decorative design or the placement of the educational material (see applicants specification page 4, lines 28-31).

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al '380 in view of Kollath et al '381. Buckley discloses a teaching aid containing most of the elements of the claims including with reference to claims 1, 8 and 13, a body having a top surface (figure 1) and a bottom surface (rear surface of figure 1), a body defining a frame around an aperture (read onto pocket 17), educational information represented on top of the body in a variety of regions, as required by claims 7 and 14 (col. 11, lines 4-7). A replaceable name tag within the aperture of the body, as required by claim 1 and 13, is described at col. 4, lines 3-5. The educational material being reading material, as required by claim 3, is described in col. 4, lines 3-5 since such material would have to be read. The name tag including additional educational material, as required by claim 8, lacking any distinguishing features is read onto the users name. A second replaceable name tag region, as required by claim 10, is shown as the second pocket 27 in figure 1.

Buckley lacks the teaching of magnetic material disposed on the bottom surface of the device as required by claims 1, 8 and 13. However, Kollath et al '381 discloses a device like that of Buckley, which teaches that it is known to provide such devices with magnetic materials on the backs thereof (figure 2, magnets 48) for the purpose of

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attachment. Therefore it would have been obvious to include magnetic materials on the back of the device of Buckley for the purpose of attachment to metallic surfaces.

Regarding claims 4-5, 8-9 and 14-15, it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to include matching decorative designs on a name tag and body of the teaching aid as well as educational material on the name tag since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of aesthetic appearance does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. decorative design and educational material) and the substrate (e.g. body of the aid and name tag) which is required for patentability. Furthermore it is the position of the examiner that the decorative design and placement of the educational material as claimed is purely a design choice in that applicants do not disclose any advantage or critical need for the decorative design or the placement of the educational material (see applicants specification page 4, lines 28-31).

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Regarding claims 2, 6, 11-12 and the requirement of a sleeve operatively connected to the back surface, it would have been obvious to construct the pocket of Buckley with such structural features since the examiner takes official notice that it is known to manufacture pockets from a front surface having an aperture and a rear surface having a sleeve to define the pocket. It is further considered that the attachment means for the name tag is an obvious choice of design as applicants clearly state that the name tag may be attached to the device in a variety of known ways (see applicants specification page 4, lines 29-30).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Dmitry Suhol
Examiner
Art Unit 3725

ds